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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,230	02/27/2004	Timothy M. Cahill	36352US1	7984
116	7590	12/09/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,230

Applicant(s)

CAHILL, TIMOTHY M.

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 - 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan.

Ryan discloses an annular shaped member (fig 2,7 item 9) having a first side and a second side, the annular shaped member having a diameter larger than a rim diameter of a basketball hoop; and a flange (item 14, fig 7) that encircles a portion of an outer edge of the annular shaped member and projects downwardly from the second side by a length greater than the rim diameter, wherein the first side of the annular shaped member is substantially smooth and flat and wherein the annular shaped member can block a basketball from passing through the basketball hoop (fig 1). In as much structure set forth, the apparatus is capable of use as claimed (MPEP 2112).

As to claim 2 : Ryan discloses an integrally formed flange (fig 6, item 14, 2:46-48).

As to claim 3 : Ryan discloses an arm extending from the member (fig 1, item 10).

Also,

Claims 1, 3,4, 6,7, 9-11, 13,14,16 ,17and,19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Booker et al. Booker et al discloses an annular shaped member (12) having a first side and a second side, the annular shaped member having a diameter larger than a rim diameter of a basketball hoop; and a flange (item 22) that encircles a portion of an outer edge of the annular shaped member and projects downwardly from the

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second side by a length greater than the rim diameter, wherein the first side of the annular shaped member is substantially smooth and flat and wherein the annular shaped member can block a basketball from passing through the basketball hoop (fig 2).

As to claim 3 : Booker et al discloses an arm and arm receiving structure (fig 1, item 30).

As to claim 4 : Booker et al discloses a rod receiving structure (fig 2, L-flange next to item 30 can receive a rod ie lock shackle).

As to claim 6 : Booker et al discloses a notch (fig 2). In as much structure set forth by the applicant in the claim, the notch between the flanges that receive the rim (support structure) meets the limitations of the claim.

As to claim 7 : Booker et al discloses a plurality of protrusions (fig 2).). In as much structure set forth by the applicant in the claim, the two flanges (22) meet the limitations of the claim.

As to claim 9 : Booker et al discloses protrusions that are concentric with the flange (fig 2, 3). In as much structure set forth by the applicant in the claim, the two flanges (22) meet the limitations of the claim.

As to claim 10 : Booker et al discloses a distance greater than the cross sectional rim diameter (fig 2, 3). The device fits over the rim.

As to claim 11 : Booker et al discloses a flange and protrusion to receive a rim (fig 3).

As to claim 13 : Booker et al discloses a rod (fig 1, item 32).

As to claim 14 : Booker et al discloses a rod receiving structure (fig 1, item 32).

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As to claim 16 : Booker et al discloses a flange and plurality of protrusions (fig 2).

As to claims 17, and 19 : See claim 1 rejection.

As to claims 20-22: See claim 1 rejection. The method claimed would naturally be used by one using the device. The device has a first side that is smooth and flat and is a circular configuration.

Also,

Claims 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll. Carroll discloses means for creating a shelf-like image (fig 2).

As to claim 18 : Carroll discloses means for covering a rim (fig 2).

As to claim 19 : Carroll discloses means for preventing a basketball from passing through a basketball goal (fig 2).

As to claims 20-22: See claim 17 rejection. The method claimed would naturally be used by one using the device. The device has a first side that is smooth and flat and is a circular configuration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Booker et al in view of Official Notice. Booker et al discloses the elements of claim 2, however it

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fails to clearly disclose the use of a unitary structure. Official Notice is taken that the use of unitary structures is well known in the art of goals. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a unitary structure in order to lower manufacturing costs. (See Davies et al 5,816,948 2:43-49)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Booker et al in view of Official Notice. Booker et al discloses the elements of claim 5, however it fails to clearly disclose the use of a threaded rod. Official Notice was taken in the prior office action that the use of various equivalent fastening means is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed any one of several equivalent fastening means based on in order to lower manufacturing costs. (See Davies et al 5,816,948 2:43-49)

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Booker et al in view of Official Notice. Booker et al discloses the elements of claim 12, however it fails to clearly disclose the use of a high-impact polymer composite. Official Notice was taken in the prior office action that the use of high-impact polymer composite is well known in the art of goals. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a unitary structure in order to decrease the weight of the device and lower manufacturing costs. (See Davies et al 5,816,948 2:43-49)

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al in view of Rapp. Davies et al discloses the elements of claim 13, however it fails to disclose the use of a rod to engage the annular member. Rapp discloses the use of a rod to engage the annular member (fig 2, item 36,37). It would have been obvious to one

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of ordinary skill in the art at the time of the invention to have employed the rod of Rapp with the device in order to easily attach and remove the device from a basketball rim.

As to claim 14: Rapp discloses a rod receiving structure (fig 2, item 36,37). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the rod of Rapp with the device in order to easily attach and remove the device from a basketball rim.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al in view of Rapp and further in view of Mattoon. The cited art fails to disclose a sectioned rod. Mattoon discloses a sectioned rod (28, 27). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the sectioned rod of Mattoon with the device in order to easily store the device when not in use.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10/19/04 have been fully considered but they are not persuasive.

With regards to Ryan, the current claim limitations merely call for an annular shaped member larger than the rim diameter of a basketball rim, a flange that encircles

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a portion of the outer edge with a first side that is smooth and flat and capable of covering a basketball rim. Ryan meets these limitations.

With regards to Booker et al, the current claim limitations merely call for an annular shaped member larger than the rim diameter of a basketball rim, a flange that encircles a portion of the outer edge with a first side that is smooth and flat and capable of covering a basketball rim. Ryan meets these limitations. The claim language of Booker does not show a criticality to the position of the brackets. The Booker device could be positioned at the edge. A dictionary provides the following definition

encircle*Function: transitive verb**1 : to form a circle around : SURROUND**2 : to pass completely around*

The claim limitation merely calls for a "portion of the edge" to be "encircled".

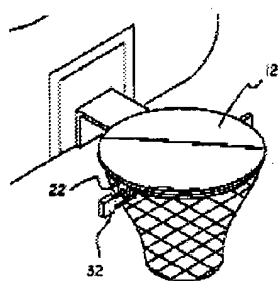
With regards the claim that the Booker art fails to disclose a "shelf", one again needs to look to the dictionary for clarity.

shelf*Function: noun**Etymology: Middle English, probably from Old English scylfe; akin to Old Norse hlithskjalf Odin's seat**1 a : a thin flat usually long and narrow piece of material (as wood) fastened horizontally (as on a wall) at a distance from the floor to hold objects b : one of several similar pieces in a closet, bookcase, or similar structure c : the contents of a shelf*

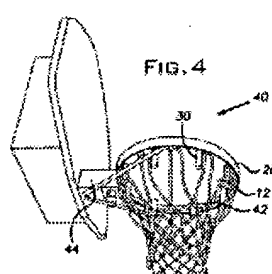
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2 : something resembling a shelf in form or position: as a : a sandbank or ledge of rocks usually partially submerged b : a flat projecting layer of rock c : the submerged gradually sloping border of a continent or island : CONTINENTAL SHELF

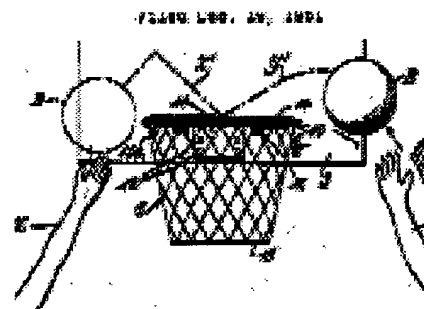
With respect to this limitation, the device of Booker et al, Carroll and the instant invention both are shelf like. Although the instant invention fails to provide a top view, each of the devices provide a "shelf that covers the basketball rim.



Booker



Instant invention



Carroll

The argument that one of ordinary skill in the art would not be aware of using a sectioned handle to position or remove the device is not understood. There are various well known means to position and place goal guards known in the art. One of ordinary skill in the art would not

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is (571)272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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710189*3122260*2911180

December 6, 2004

Michael Chambers
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